

Appln. No. 09/870,801
Amdt. dated March 26, 2004
Reply to Office action dated Sept. 26, 2003

PATENT
Customer No. 22,852
Attorney Docket No. 7451.0001-18000
InterTrust Ref. No.: IT-5.2.1.1 (US)

REMARKS / ARGUMENTS

In response to the Office action dated September 26, 2004, Applicants respectfully request the Office to enter the following amendments and consider the following remarks. By this response, claims 91, 93, 94, 96, 97, 103, 121, 123, and 126-128 have been amended. With respect to the pending claims, claims 91-128 remain pending in this application (claims 1-90 were canceled without prejudice via preliminary amendment).

In the Office action, the Examiner: (i) rejected claims 91-95, 103-104 and 121-127 under 35 U.S.C. § 112, first paragraph, (ii) rejected claims 93, 97, 103, 123 and 128 under 35 U.S.C. § 112, second paragraph, (iii) rejected claims 91-127 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter, (iv) rejected claims 91-96, 98-107, and 111-128 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 5,715,403 to Stefik ("Stefik"), and (v) rejected claims 108-110 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Stefik in view of U.S. Patent No. 5,457,746 to Dolphin ("Dolphin").

Applicants respectfully request reconsideration of the above rejections for the reasons set forth below.

Information Disclosure Statement

The Office has indicated that the information disclosure statement filed 06/03/2003, Paper No. 5, is not available to the examiner. Applicants are unsure if the missing IDS refers to the Information Disclosure Statement/Notice of Litigation filed October 31, 2002, or the Updated Notice Regarding Related Litigation dated April 3, 2003. Applicants note, however, that neither of these submissions appears in the U.S. Patent Office's PAIR records. Therefore, Applicants enclose herewith (at Tabs 1 and 2, respectively) copies of these submissions as well as copies of the stamped, returned post cards that were mailed along with both of these disclosure statements. Both of these submissions include two types of information: (1) papers from a related court proceeding, attached as exhibits or tabs, and (2)

Appln. No. 09/870,801
Amdt. dated March 26, 2004
Reply to Office action dated Sept. 26, 2003

PATENT
Customer No. 22,852
Attorney Docket No. 7451.0001-18000
InterTrust Ref. No.: IT-5.2.1.1 (US)

other references that are provided in list format (either in a form PTO-1449, or in the same lists provided during litigation). In an abundance of caution, all of this information is being resubmitted herewith as follows.

With respect to the combined Information Disclosure Statement / Notice of Litigation filed October 31, 2002, the IDS and the Notice of Litigation (with all of the associated documents, Exhibits A-M) are being resubmitted herewith in paper form (1st Attachment hereto), as they were originally submitted. Regarding the 3 pages of references cited on the form PTO-1449, these references are being resubmitted via CD-ROM entitled "IDS materials previously submitted on 10/31/02," attached (2nd Attachment hereto).

With respect to the Updated Notice of Related Litigation filed April 3, 2003, it and all of the associated documents (Tabs 1-11) are also being resubmitted herewith in paper form, as they were originally submitted (3rd Attachment hereto). Regarding Exhibits F and G to Microsoft Corporation's Patent Local Rule 4-2 Disclosure of Preliminary Claim Construction and Extrinsic Evidence (Limited to 'Mini-Markman' Claims)" (Tab 8), all of these references are cited in the Information Disclosure Statement (form PTO-1449) being submitted herewith (on March 26, 2004) in a separate IDS document.

Rejection of Claims 91-95 and 121-127 under 35 U.S.C. § 112, 1st paragraph

Claims 91-95 and 121-127 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement in that the "description of a public portion and a private portion is not supported in the specification."

Claims 91-95 and 121-127 also stand rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to enable "a public portion and a private portion" in the specification.

Applicants respectfully submit that description of a public portion and a private portion is supported by and enabled in the specification. By way of

example, Applicants direct the Examiner's attention to FIG. 23, and the related discussion in the specification, which includes examples of the layout for a load module public header and a load module private header. See, application as filed, pg. 353, line 6 - pg. 361, line 24, with public/private header examples at pg. 356, line 1 - pg. 358, line 15. Therefore, it is respectfully submitted that the claimed public portion and private portion subject matter is supported and enabled by at least these portions of the specification. The Examiner is invited to contact Applicants should he need any assistance in locating additional support for a particular claim element.

Claims 103 and 104 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement in that the "description of a public tag and a private tag are not supported in the specification."

Claims 103 and 104 also stand rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to enable "a public tag and a private tag" in the specification.

Applicants respectfully submit that such use of public tags and private tags is supported and enabled in the written description. By way of example, Applicants direct the Examiner's attention to the discussion appearing at pg. 219, line 6 - pg. 220, line 10 of the application as filed. Therefore, it is respectfully submitted that the claimed subject matter is supported and enabled by at least this portion of the specification.

Rejection of Claims 93, 97, 103, 123 and 128 under 35 U.S.C. §112, 2nd paragraph

Claims 93 and 123 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to provide antecedent basis for the term "the type of computer" in line 2 of claim 93, and in line 2 of claim 123.

Applicants have amended claims 93 and 123 to each recite "a type of computer" so as to remove any need for antecedent basis. Applicants respectfully submit that these rejections to claims 93 and 123 are thereby overcome.

Similarly, claim 103 stands rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to provide antecedent basis for the term "the public tag" in line 3 of claim 103.

Applicants have amended claim 103 to recite "a public tag" so as to remove any need for antecedent basis. Applicants respectfully submit that the rejection to claim 103 has thereby been overcome.

Claim 97 stands rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for using a trademark to attempt to identify/describe the operating system.

Although Applicants respectfully disagree that the usage here is indefinite, in order to expedite prosecution Applicants have amended claim 97 to remove the reference to a trademark, and respectfully submit that the instant rejection is now moot.

Claim 128 stands rejected under 35 U.S.C. § 112, second paragraph, as allegedly being incomplete for omitting essential elements, such omission amounting to a gap between the elements.

Although Applicants respectfully disagree with the Examiner's basis for this rejection, in order to expedite prosecution Applicants have amended claim 128 to more clearly recite the nexus between system elements, and thus respectfully submit that claim 128 is allowable.

Rejection of Claims 91-127 under 35 U.S.C. § 101

Claims 91-95 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. These claims now reflect that the load module header and the load module body are embodied on a computer-readable medium. Accordingly, Applicants respectfully submit that this rejection has been overcome.

Claims 96-120 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. These claims now reflect that the

operating system, comprising validation programming and communications programming, is embodied on a computer readable medium. Accordingly, Applicants respectfully submit that this rejection has been overcome.

Claims 121-125, 126 and 127 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. These claims now reflect that the respective component assemblies are embodied on computer readable media. Accordingly, Applicants respectfully submit that the rejection of these claims has been overcome.

Rejection of Claims 91-96, 98-107 and 111-128 under 35 U.S.C. § 102(b)

Claims 91-96, 98-107, and 111-128 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Stefik.

Claim 91 recites a load module that includes a header and a body that includes executable programming specifying that information relating to a use of the load module be communicated to a remote site.

Applicants respectfully submit that Stefik does not teach or disclose, *inter alia*, a load module that includes executable programming specifying that information relating to a use of the load module be communicated to a remote site. Instead, the cited portions of Stefik describe billing for the use of a digital work (see, e.g., Office Action at page 8, citing Stefik, col. 29 lines 60-61 and col. 30, lines 10-22). There is no indication that the digital work itself comprises a load module including executable programming specifying that information relating to a use of the load module be communicated to a remote site. For at least these reasons, Applicants respectfully submit that Claim 91 is not anticipated by Stefik.

Claims 92-95 are dependent on Claim 91, and are thus allowable for at least the reasons set forth above in connection with Claim 91.

Claim 96 recites an operating system that includes component assembly programming which assembles a plurality of elements into a component.

Applicants submit that Stefik does not teach or disclose, *inter alia*,

component assembly programming which assembles a plurality of elements into a component. Instead, the cited portions of Stefik describe printing or viewing one or more digital works, where each digital work may have multiple parts (see, e.g., Office Action at page 9, citing Stefik, col. 30, lines 38-62). However, there is no indication that the digital works that are being printed or viewed are assembled into a component of a component assembly in the manner recited in claim 96. For at least these reasons, Applicants respectfully submit that Claim 96 is not anticipated by Stefik.

Claims 98-107 and 111-120 are dependent on Claim 96, and are thus allowable for at least the reasons set forth above in connection with Claim 96.

Claim 121 recites a component assembly comprising first and second load modules, in which at least one load module comprises executable programming requiring the storage of audit information relating to the use of the component assembly.

Applicants submit that Stefik does not teach or disclose, *inter alia*, a component assembly that includes load module executable programming requiring the storage of audit information relating to the use of the component assembly. Instead, the cited portions of Stefik describe billing for the use of a digital work (see, e.g., Office Action at page 17, citing Stefik, col. 29 lines 60-61, and col. 30, lines 23-26). There is no indication that the digital work comprises a component assembly or load module comprising executable programming requiring the storage of audit information relating to the use of the component assembly. For at least these reasons, Applicants respectfully submit that Claim 121 is not anticipated by Stefik.

Claims 122-125 are dependent on Claim 121, and are thus allowable for at least the reasons set forth above in connection with Claim 121.

Claim 126 recites a component assembly comprising a load module including executable programming requiring the storage of information uniquely identifying a device at which the component assembly is stored.

Applicants respectfully submit that Stefik does not teach or suggest a load module including executable programming requiring the storage of information uniquely identifying a device at which the component assembly is stored, as recited in claim 126, and, furthermore, that portions of Stefik that correspond to the claim language have not been identified by the Examiner (e.g., where, in Stefik, a load module including executable programming requiring the storage of information uniquely identifying a device at which a component assembly is stored - see Office Action at pages 18-19). Passages cited from Stefik by the Office are purported to show executable programming specifying that information relating to a use of a load module be communicated to a remote site (see Office Action at page 19, citing Stefik, col. 29 lines 60-61, and col. 30, lines 23-26). As set forth above in connection with Claim 91, Applicants have explained that the cited portions of Stefik do not disclose this material. Moreover, Applicants submit that the elements discussed in the cited portions of Stefik are not the same as a load module including executable programming requiring the storage of information uniquely identifying a device at which a component assembly is stored, as recited in Claim 126. For at least these reasons, Applicants respectfully submit that Claim 126 is not anticipated by Stefik.

Claim 127 recites a component assembly comprising first and second load modules, in which at least one of the load modules includes executable programming requiring communicating a unique identification for a device at which said component assembly is stored to a remote location.

Applicants respectfully submit that the Examiner has not identified where Stefik discloses a load module including executable programming requiring communicating a unique identification for a device at which said component assembly is stored to a remote location (see Office Action at pages 20-21). Instead, the Examiner cites passages in Stefik that allegedly show executable programming specifying that information relating to a use of a load module be communicated to a remote site (see Office Action at page 21, citing Stefik, col. 29

lines 60-61, and col. 30, lines 23-26). As set forth above in connection with Claim 91, Applicants respectfully disagree that the cited portions of Stefik disclose this material. However, Applicants also submit that even if Stefik did disclose a load module including executable programming specifying that information relating to a use of the load module be communicated to a remote site, as recited in Claim 91, that element is not the same as a load module including executable programming requiring communicating a unique identification for a device at which said component assembly is stored to a remote location, as recited in Claim 127. For at least these reasons, Applicants respectfully submit that Claim 127 is not anticipated by Stefik.

Claim 128 recites a computer processing system that includes a component assembler which assembles a plurality of elements into a component assembly. Applicants respectfully submit that Stefik does not teach or disclose, *inter alia*, a component assembler which assembles a plurality of elements into a component assembly. Instead, the cited portions of Stefik describe printing or viewing one or more digital works, where each digital work can have multiple parts (see, e.g., Office Action at page 21, citing Stefik, col. 30, lines 38-62). However, there is no indication that the one or more digital works that are being printed or viewed are assembled into a component assembly by a component assembler such as that recited in claim 128. For at least these reasons, Applicants respectfully submit that Claim 128 is not anticipated by Stefik.

Rejection of Claims 108-110 under 35 U.S.C. § 103(a)

Claims 108-110 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Stefik in view of U.S. Patent No. 5,457,746 to Dolphin ("Dolphin").

All of the claims subject to the instant rejection are ultimately dependent on Claim 96, and are thus allowable for at least the reasons set forth above in connection with Claim 96.

Appln. No. 09/870,801
Amdt. dated March 26, 2004
Reply to Office action dated Sept. 26, 2003

PATENT
Customer No. 22,852
Attorney Docket No. 7451.0001-18000
InterTrust Ref. No.: IT-5.2.1.1 (US)

Conclusion

In view of the foregoing amendments and remarks, Applicants submit that the pending claims are in allowable form, and respectfully request reconsideration of the rejections and the timely allowance of the claims.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 26, 2003

By: _____


Andrew B. Schwaab
Reg. No. 38,611

Finnegan Henderson Farabow
Garrett & Dunner L.L.P.
1300 I Street, NW
Washington, D.C. 20005
(202) 408-4000

Attachments:

- 1st - Notice of Litigation (w/Exhibits), filed 10/31/02**
- 2nd - CD-ROM containing references from IDS filed 10/31/02**
- 3rd - Updated Notice of Related Litigation (w/Attachments) filed 4/3/03**



UNITED STATES PATENT AND TRADEMARK OFFICE

MCE/LJT/ABS/MZM
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,801	06/01/2001	Karl L. Ginter	7451.0001-18000	9392
22852	7590	05/20/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			DARROW, JUSTIN T	
			ART UNIT	PAPER NUMBER
			2132	8
DATE MAILED: 05/20/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED
MAY 24 2004
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
GARRETT

Petition for Re-examination

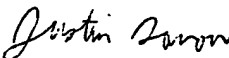
Delmas
05/20/04

Notice of Abandonment	Application No.	Applicant(s)	
	09/870,801	GINTER ET AL.	
	Examiner	Art Unit	
	Justin T. Darrow	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 26 September 2003.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:


JUSTIN T. DARROW
PRIMARY EXAMINER
TECHNOLOGY CENTER 2100

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.